REMARKS

Claims 1-17 are rejected a obvious from *Gao* (U.S. Patent No. 6,095,650) in view of *Foley* (U.S. Patent No. 6,535,223). However, Applicant herewith encloses a Declaration swearing behind the *Foley* reference.

The enclosed Declaration renders the *Foley* reference inoperative, but nevertheless the Applicant would like to comment on the combination of *Foley* with *Gao*. The Applicant respectfully submits that this combination of references would not render the present application obvious, because, among other things, the suggestion and motivation to combine the references, discussed on page 4 of the Office Action, are not found in the prior art, but rather are formulated in hindsight.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Furthermore, in *Ecolochem, Inc. v. Southern California Edison Company*, 227 F.3d 1361, 56 USPQ2d 1065, 1075-76 (Fed.Cir. 2000), *cert. denied*, 121 S.Ct. 1607, the court stated that an obviousness claim lacking evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis, and thus a rigorous application of the requirement for showing a motivation or teaching to combine the prior art references must be made. See also *Lindemann Maschinensabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, (Fed. Cir. 1984) where the court explained that to reject a claim on obviousness by combining references, there must be in the prior art as a whole something "to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinensabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452; 221 USPQ 481 (Fed. Cir. 1984). The mere fact that iris size is uniform in humans, and the fact that pixel measurements are common in digital imaging, do not suggest the desirability of combining the *Gao* and *Foley* references.

CONCLUSION

For all of these reasons, it is not perceived how the claimed invention can be derived from the valid prior art, or how it might be obvious in view of the valid prior art, or even in further view of *Foley* which is not valid as prior art. The references do not suggest what is set out in the applicant's claims, and do not provide the basis for developing the invention to persons having ordinary skill in the art to which the subject matter pertains. Therefore, withdrawal of the rejections is respectfully requested, and early allowance is earnestly solicited.

Respectfully submitted,

Dated: Dec. 30, 2003

Andrew T. Hyman
Attorney for Applicant
Registration No. 45,858

WARE, FRESSOLA, VAN DER
SLUYS & ADOLPHSON LLP
Building Five, Bradford Green
755 Main Street, P.O. Box 224
Monroe, CT 06468
Telephone (203) 261-1234
Facsimile (203) 261-5676
USPTO Customer No. 004955